

REMARKS

Applicants respectfully request reconsideration of the above-identified application in light of the present amendment and response. Claims 1-19 are pending. The Examiner has rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Dunn et al. (US 5,614,243) in view of Asher et al. (US 5,215,777).

Applicants have amended independent claims 1 and 12 to include a further limitation to a hot-fill process and that a smooth texture is maintained after the hot-fill process.

**35 U.S.C. § 103(a) Rejections**

The Examiner has rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Dunn et al. [hereinafter Dunn] in view of Asher et al. [hereinafter Asher]. Applicants have amended independent claims 1 and 12 to better define the claimed invention. Applicants also respectfully disagree with the Examiner's characterization of the references or that Dunn and Asher would be combined to arrive at the claimed product.

Both independent claims now recite that a dairy product containing the aqueous solution can be packaged using a hot fill process while maintaining a smooth texture. Support for this amendment is found in Applicants' specification on page 5, lines 14-24.

Neither Dunn nor Asher disclose a hot-fill packaging process. Asher provides a process for producing an ice cream, which involves a freezing step 48 with an extrusion of the ice cream at about -6°C. (Col 4, lines 15-24.) Clearly Asher cannot teach the use of the present composition in a hot-fill process.

Dunn teaches a specific method for preparing a texturizing agent containing an "insoluble microparticle." (Col. 2, lines 6-7.) If the specific method is not followed, Dunn teaches that a product having a gritty and poor mouthfeel is obtained; of course, such a product is unacceptable. Applicants' product is

produced from a process using temperatures of 60 to 100°C, which, according to Dunn, should produce a gritty and poor mouthfeel—not a smooth texture as recited in amended claims 1 and 12. As will be more further discussed below, modifying the temperatures in Dunn to the claimed range (i.e., 60 to 100°C) to prepare the aqueous composition would *not*, according to the specific teaching of Dunn, produce a product having a smooth texture, but would be gritty and have a poor mouthfeel. According to section 2113 of the Manual of Patent Examining Procedure [hereinafter MPEP], the structure implied by the process steps is to be considered when assessing the patentability of product-by-process claims, *especially where the manufacturing process imparts distinctive structural characteristics to the final product.*

As specifically stated in Dunn, the manufacturing process imparts distinctive structural characteristics to the final product. For example, if the teachings of Dunn regarding temperatures (i.e. 125 to 150°C, with 138°C being preferred) are not followed, then a product having a gritty and poor mouthfeel is obtained. Dunn specifically states:

For the purposes of the present invention, the term “texturing agent” will be used to describe products derived from high amylose (>30 % amylose as determined by iodine binding) starch that have been processed *under specific conditions* of temperature, pressure, and shear . . . .

\* \* \*

The importance of the final temperature used in the present invention is illustrated by the following comparison. High amylose starch was heated to a maximum temperature in the reactor of 121°C for 8 hours in the absence of shear. Even though the cooking process is carried out for a much longer time period than that of the present invention, this lower temperature does not

allow for complete solubilization and disruption of the starch granules resulting in a product that contains relatively large particulates that exhibit *grittiness and poor mouthfeel* when tasted directly.

(Col. 3, lines 1-5 and Col. 5, lines 15-24.) (Emphasized added.)

Dunn teaches a specific method for preparing a texturizing agent containing an "insoluble microparticle." (Col. 2, lines 6-7.) If the specific method is not followed, Dunn teaches that a product having a gritty and poor mouthfeel is obtained; of course, such a product is unacceptable. Applicants' product is produced from a process using temperatures of 60 to 100°C, which, according to Dunn, should produce a gritty and poor mouthfeel—not a smooth texture as recited in amended claims 1 and 12. The process in the claims and the process of Dunn each impart distinctive characteristics to the final product; as a result, such differences are critical in determining patentability. (See MPEP § 2113.) According to Dunn, Applicants' process should produce an unacceptable product. Thus, Dunn teaches away from the present invention.

Applicants further disagree that Dunn and Asher can be combined to arrive at the claimed product. The Examiner has provided no motivation for one of ordinary skill in the art to ignore the specific teachings of each reference in order to arrive at the claimed invention. As stated above, Dunn teaches a specific method to arrived at its product and indicates that deviation from such method produces a product having a gritty and poor mouthfeel; thus, Dunn teaches away from being modified or combined with Asher as suggested by the Examiner. Asher teaches different process steps, different ingredients, and lower temperatures, which, according to Dunn, would not produce an acceptable product. Based on the specific disclosures in Dunn, one skilled in the art would not be motivated to combine the references in the manner suggested by the examiner.

Application No. 10/699,726  
Amendment dated September 21, 2004  
Reply to Office Action of June 28, 2004

Lastly, the Examiner has noted that in "the absence of unexpected results, it is not seen how the claimed invention differs from the teachings of the prior art." Applicants respectfully submit that such unexpected results have indeed been shown. The resulting food compositions containing the aqueous composition of this invention exhibit "improved texture and, therefore, mouth-feel, as no uncontrolled or undesired protein agglomeration occurs during processing, e.g. heat-treatment or hot-filling." (Spec., Pg. 5, lines 14-16.) Thus, Applicants have provided an aqueous composition that acts as a stabilizer and texturizing agent which when combined with a dairy product allow the dairy product to be packaged using a hot-fill process and thereby obtain increased shelf-life without the loss of texture. Applicants respectfully submit that these are surprising results. Indeed, and as detailed above, the art cited and relied upon by the Examiner (i.e., Dunn) actually teaches away from the present invention.

Applicants respectfully request that the rejections to claims 1-19 be withdrawn in light of the present amendment and response.

### **Conclusion**

Applicants respectfully request that the Examiner allow pending claims 1-19 and pass this Application to issue.

If the Examiner believes that a telephonic or personal interview would be helpful to terminate any issues which may remain in the prosecution of the Application, the Examiner is requested to telephone Applicants' attorney at the telephone number set forth herein below. The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 06-1135.

Application No. 10/699,726  
Amendment dated September 21, 2004  
Reply to Office Action of June 28, 2004

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By



Richard A. Kaba

Registration No. 30,562

September 21, 2004

120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone (312) 577-7000  
Facsimile (312) 577-7007